

Application No.: 10/824,349  
Reply dated January 25, 2007  
to Office Action of October 25, 2006  
Page 13 of 25

Docket No.: 1248-0715PUS1

**AMENDMENTS TO THE DRAWINGS**

The attached replacement sheet of drawing includes new FIG. 7, which is based upon original FIG. 2.

## **REMARKS/ARGUMENTS**

### **STATUS OF CLAIMS**

In response to the Office Action dated October 25, 2006, claims 1-10, 13 and 17 have been amended, and claims 24-27 have been added. Claims 1-3, 7-11, 13, 14, 17, 18, 20-22 and 24-27 are now pending in this application. No new matter has been added. Claims 4-6, 12, 15, 16, 19 and 23 have been withdrawn from consideration as directed to non-elected species.

The indication that claims 17 and 18 are allowable, and that claim 13 is objected to, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

Claim 17 has been amended to add “and” after “...cover at the enablement section...” This is a non-narrowing claim amendment.

### **OBJECTION TO CLAIM 13**

Claim 13 has been objected to as the Examiner contends that “said cover comprises a shock absorbing device” is unclear since the cover functions as “shock absorbing device”.

By this response, claim 13 has been amended to recite:

said cover is adapted to engage an actuator on the auxiliary device when said cover is secured to said image forming device in the second manner and is to function as a shock absorbing device.

Claim 13 has also been amended to be in independent form including all the limitations of base claim 10. Consequently, amended claim 13 is believed to be allowable.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 101**

Claims 20-22 have been rejected under 35 U.S.C. § 101 as “the claimed invention is not supported by either a credible asserted utility or a well established utility”.

The rejections are respectfully traversed.

As set forth in MPEP § 2107:

C) Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support the factual basis for the *prima facie* showing of no specific and substantial credible utility. If documentary evidence is not available, the examiner should specifically explain the scientific basis for his or her factual conclusions.

(1) Where the asserted utility is not specific or substantial, a *prima facie* showing must establish that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. The *prima facie* showing must contain the following elements:

- (i) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is not both specific and substantial nor well-established;
- (ii) Support for factual findings relied upon in reaching this conclusion; and
- (iii) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(2) Where the asserted specific and substantial utility is not credible, a *prima facie* showing of no specific and substantial credible utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention. The *prima facie* showing must contain the following elements:

- (i) An explanation that clearly sets forth the reasoning used in concluding that the asserted specific and substantial utility is not credible;
- (ii) Support for factual findings relied upon in reaching this conclusion; and

(iii) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(3) Where no specific and substantial utility is disclosed or is well-established, a *prima facie* showing of no specific and substantial utility need only establish that applicant has not asserted a utility and that, on the record before the examiner, there is no known well-established utility.

Clearly, the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Independent claim 20 recites:

In an image forming device including an attachment section at which an auxiliary device is attachable to the image forming device and a removable cover for covering the attachment section when no auxiliary device is attached to the attachment section, a method of preventing a loss of the removable cover comprising the steps of:

configuring the auxiliary device or the image forming device so as to be inoperable when the auxiliary device is connected to the image forming device unless an enabling device is connected to the image forming device; and  
configuring the removable cover as the enabling device.

Thus, claim 20 is directed to a method of *preventing a loss of a removable cover* that is part of an image forming device (asserted utility) that includes both an attachment section at which an auxiliary device is attachable to the image forming device, as well as a removable cover for covering the attachment section when no auxiliary device is attached to the attachment section. In order to prevent loss of the removable cover, there is a step of configuring the auxiliary device or the image forming device to be inoperable when the auxiliary device is connected to the image forming device unless an enabling device is connected to the image forming device, and a step of configuring the removable cover as the enabling device. By

configuring the removable cover as the enabling device, when the auxiliary device is connected to the image forming device, the removable cover must be connected to the image forming device (i.e., ***not lost***) in order for the auxiliary device or the image forming device to operate. This subject matter is supported by the description, for example, at page 24, line 24 to page 25, line 9.

Further, in the above control system, when the detector 54 determines that the postprocessing device 50 is not properly fitted to the image forming device 1, the control circuit controls the postprocessing device 50 and the image forming device 1 not to operate. However, the control circuit may control only the image forming device 1 not to operate. This is because, also in this case, the connector cover 40 is necessary when the postprocessing device 50 is fitted to the image forming device 1, ***which eliminates mistaken disposal and loss of the connector cover 40.*** (Emphasis Added)

Since the claimed invention has an asserted utility, in order to support the utility rejection, the Examiner must establish a *prima facie* showing in the manner set forth in either MPEP § 2107 (C)(1) or MPEP § 2107 (C)(2). In particular, under the current guidelines regarding lack of utility, the Examiner must provide documentary evidence to support the factual basis needed to establish a *prima facie* showing of no utility of the claimed invention. However, in the present Office Action, the Examiner has merely asserted the factual finding that the claimed invention has no specific tangible result, but has **NOT** provided any support for this factual finding.

Thus, the Examiner has not met his burden of establishing a *prima facie* showing that the claimed inventions have no utility. Consequently, withdrawal of the rejection of independent claim 20, as well as of dependent claims 21 and 22, under 35 U.S.C. § 101, in that “the claimed

invention is not supported by either a credible asserted utility or a well established utility”, is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

Claims 20-22 have been rejected under 35 U.S.C. § 112, first paragraph, as the Examiner contends that “the claimed invention is not supported by either a credible asserted utility or a well established utility”.

The rejections are respectfully traversed.

As noted above, page 24, line 24 to page 25, line 9 describe:

Further, in the above control system, when the detector 54 determines that the postprocessing device 50 is not properly fitted to the image forming device 1, the control circuit controls the postprocessing device 50 and the image forming device 1 not to operate. However, the control circuit may control only the image forming device 1 not to operate. This is because, also in this case, the connector cover 40 is necessary when the postprocessing device 50 is fitted to the image forming device 1, *which eliminates mistaken disposal and loss of the connector cover 40.* (Emphasis Added)

Clearly, for the reasons set forth above, the claimed steps have utility in “helping prevent mistaken disposal and loss of the removable cover”, as recited in independent claim 20. In addition, as noted above, in the present Office Action, the Examiner has **NOT** provided the documentary evidence required to support the factual finding that the claimed invention has no specific tangible result. Consequently, withdrawal of the rejection of claims 20-22 under 35 U.S.C. § 112, first paragraph, is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1-3 and 7-9 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that “serving a second function which is different from the first function while maintaining the first function, such that the external cover is provided to the first device or the second device in a state different from a state when the second device is not fitted to the main unit of the first device” is indefinite. The Examiner also contends that it is unclear how the external cover is provided to the second device when it is not shown in the figures. Finally, the Examiner maintains that the claims do not define an “external cover”. However, of claims 1-3 and 7-9, only claims 1-3 and 7 are directed to an “external cover”.

With regard to it being unclear how the external cover is provided to the second device when it is not shown in the figures, new Figure 7 is provided on a replacement sheet and is based upon original Figure 2. The specification has been amended at appropriate locations with regard to new Figure 7. In Figure 7, elements 53 and 54 are provided on printer 2 while external cover 40 is on the postprocessing device. This is opposite to what is shown in Figure 2 and is consistent with what is described at page 24, lines 16-22 and with what is recited in the claims.

As to the other issues, case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in

the art. *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 USPQ 568, 574 (Fed. Cir. 1984).

In determining definiteness, no claim may be read apart from and independent from the disclosure on which it is based. *In re Cohn*, 169 USPQ 95, 98 (CCPA 1971); *In re Kroekel*, 183 USPQ 610, 612 (CCPA 1974):

... claims are not to be considered in a vacuum, "but always in light of the teachings of the prior art and the particular application disclosure as it would be viewed by one possessing the ordinary level of skill in the pertinent art." When considered in light of the prior art and the specification, claims otherwise indefinite may be found reasonably definite.

The Examiner's difficulty concerning clarity results from the fact that the Examiner is reading the claims in a vacuum and not in light of the specification. The subject matter recited in the claims is supported, for example, by the disclosure at page 10, line 17 to page 11, line 15, page 13, lines 7-23, page 14, lines 13-24, page 15 lines 19-25, and page 24, lines 12-23.

The criticism of the claims is urged to be directed to breadth of scope and not indefiniteness. As such, the rejection improperly attempts to limit the scope of the claims by requiring additional limitations under the guise that such limitations are necessary to make the claims definite.



It is submitted that when the claim language is read in light of the specification, an artisan would readily understand the metes and bounds of the invention. The fact that a claim is broad does not justify a rejection on the ground that the claim is indefinite or incomplete (see § 706.03(d) of the M.P.E.P.).

It should be noted also that the disclosure need not recite the claim language in *haec verba*. *In re Smith*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973).

At any rate, independent claim 1 has been amended to be directed to “A device which is a first device for fitting a second device thereto, the device comprising: an attaching section to which the second device is fitted; and a removable cover that can be entirely detached from a main unit of the first device...” Other changes have been made to more clearly delineate the invention. Dependent claims 2-7 have been amended for consistency with amended independent claim 1. Independent claims 8 and 9 have been amended to be directed to a removable cover and portions of claims 9 that are directed to the removable cover have been amended similar to independent claim 1.

Thus, claims 1-3 and 7-9, as amended, are believed to recite the invention with the degree of precision and particularity required by the statute. Therefore, it is respectfully urged that the rejection be withdrawn.

As amended independent claims 8 and 9 are not otherwise rejected, they are believed to allowable.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102**

Claims 1, 7, 10, 11 and 14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Cavello et al. (USPN 5,769,646).

Cavello et al. (USPN 5,769,646) is a reference cited by the Examiner, but has not been listed on a PTO-892. Consequently, the Examiner is respectfully requested to issue a PTO-892 with Cavello et al. (USPN 5,769,646) listed so that it will appear as a cited (and considered) reference in any patent that may issue.

To expedite prosecution, independent claim 1 has been amended to recite:

A device which is a first device for fitting a second device thereto, the device, comprising:

an attaching section to which the second device is fitted; and

a removable cover that can be entirely detached from a main unit of the first device,

when the second device is not fitted to the main unit of the first device, the removable cover serving a first function as a cover for the attaching section,

when the second device is fitted to the main unit of the first device, the removable cover serving a second function which is different from the first function, such that the removable cover is entirely detached from the first device at a location at which the removable cover serves as a cover for the attaching section and then reattached to one of either the first device and the second device in a state different from a state when the second device is not fitted to the main unit of the first device.

In addition, independent claim 10 has been amended to recite:

An image forming device comprising:

an attachment section at which said image forming device is connectable to an auxiliary device; and

a removable cover attachable to said image forming device in a first manner to cover said attachment section and in a second manner to enable said image forming device and the auxiliary device to function together when the auxiliary device is connected to said image forming device, wherein

when the removable cover is to be attached in the second manner after it is attached in the first manner, the removable cover is entirely detached from the image forming device and then reattached to the image forming device in the second manner.

Thus, amended independent claims 1 and 10 require that the removable cover be *entirely detached* from the image forming device when it is to be attached in the second manner after it is attached in the first manner. In contrast, the electrical connector guard 12 of Cavello et al. always remains attached to the personal computer 10 as it moves from one position to another, or to serve a second function after serving a first function. Thus, amended independent claims 1 and 10 are patentable over Cavello et al., as are dependent claims 7, 11 and 14. Therefore, the allowance of claims 1, 7, 10, 11 and 14, as amended, is respectfully solicited.

### **REJOINDER**

If independent claims 1, 10, 17 and 20, as amended, are allowed, claims 4-6, 12, 15, 16, 19 and 23 will depend from allowed claims. In such case, withdrawal of the restriction requirement as to claims 4-6, 12, 15, 16, 19 and 23 [non-elected species] and examination on the merits of these formerly non-elected species are respectfully solicited (see MPEP § 821.04 Rejoinder).

### **NEW CLAIMS**

Claims 24-27 are submitted. Independent claim 24 recites:

In an image forming device including an attachment section at which an auxiliary device is attachable to the image forming device and a removable cover for covering the attachment section when no auxiliary device is attached to the

attachment section, a method of using an enabling device to connect the auxiliary device to the image forming device comprising:

    configuring the auxiliary device or the image forming device so as to be inoperable when the auxiliary device is connected to the image forming device unless the enabling device is connected to the image forming device; and  
    using the removable cover as the enabling device.

Thus, independent claim 24 is similar to independent claim 20, and dependent claims 25-27 are similar to dependent claims 21-23. As claims 20-21 were not rejected under either 35 U.S.C. § 102 or 35 U.S.C. § 103, claims 25-27 are believed to be allowable.

#### **CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

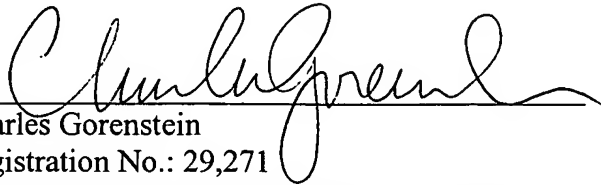
Application No.: 10/824,349  
Reply dated January 25, 2007  
to Office Action of October 25, 2006  
Page 25 of 25

Docket No.: 1248-0715PUS1

additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 25, 2007

Respectfully submitted,

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